

REMARKS

Claims 33-42 were pending in the subject application. Applicants have herein canceled claim 34 without prejudice and amended claims 33 and 41-42. Support for these amendments may be found *inter alia* in the specification as follows: page 4, lines 19-25; page 79, lines 7-17; page 65, lines 12-26. This amendment does not involve any issue of new matter. Therefore, entry of this amendment is respectfully requested such that claims 33 and 35-42 will be pending.

Rejection under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 33-42 under 35 USC 112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the claimed invention. In response, applicants respectfully traverse the Examiner's rejection. Nevertheless, applicants without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application, have herein amended the claims. In particular, applicants point out the following. (A) With respect to the incubation, claim 33 has been amended to recite "in vitro" thereby rendering moot this rejection. (B) With respect to the recitation "other than a termini of the antibody," claim 33 has been amended to now recite "in the hinge region" and claim 34 has been canceled without prejudice, thereby rendering this rejection moot. (C) With respect to the term "hybrid" within claim 41, this claim has been amended such that it no longer recites "hybrid" thereby rendering this rejection moot. (D) With respect to the Examiner's question regarding how an antibody can be a fragment, claim 33 has been amended to recite "or antigen binding fragment thereof" thus providing basis for the recitation of particular fragment types in claim 41. (E) Claim 34 has been canceled without prejudice, thereby rendering moot the Examiner's concerns with claim 34. Applicants contend that these amendments obviate the above rejections and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Rejection under 35 U.S.C. 112, first paragraph

The Examiner rejected claims 33-42 under 35 U.S.C. 112, first paragraph, alleging that the claims were not enabled. In response, applicants respectfully traverse the Examiner's rejection. It appears that the Examiner is conceding that the specification is enabling for

antibodies that do bind antigen and wherein the phosphate groups remain attached after incubation in vitro. Accordingly, the claims have been amended such that they recite that the kinase recognition site “does not adversely affect the ability of the antibody or antigen binding fragment to bind antigen.” In addition, the claims have been amended to recite that the incubation is “in vitro.” Applicants contend that these amendments obviate the above rejection and respectfully request that the Examiner reconsider this ground of rejection.

Rejection under 35 U.S.C. 102

The Examiner rejected claims 33-34, 37 and 39-41 under 35 USC 102(b) as being allegedly anticipated by Lin et al. The Examiner states that the cited reference teaches an antibody that has a kinase recognition site engineered at the C-terminus of the heavy chain. In response, applicants point out that the claims have been amended to recite that the kinase recognition site is located in the hinge region. The cited reference does not describe the invention as recited in the amended claims. Applicants contend that this amendment obviates the above rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Rejection under 35 U.S.C. 103


The Examiner rejected claims 33-34, and 37-42 under 35 USC 103 as being allegedly obvious by Lin et al. in view of Pestka et al (US Patent No. 5,986,061) (the “’061 patent”). As discussed above, the Examiner states that Lin et al teaches an antibody that has a kinase recognition site engineered at the C-terminus of the heavy chain. In response, applicants submit that neither Lin et al nor the ‘061 patent either alone or in combination teaches the claimed invention as amended, which now recites that the kinase recognition site is located in the hinge region. Applicants contend that this amendment obviates the above rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. PBLI-P01-007 from which the undersigned is authorized to draw.

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Respectfully submitted,

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